

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-2, 4-30 and 35-36 are presently active in this case. Withdrawn Claims 31-34 are canceled without prejudice. The present Amendment amends Claims 1-2, 5-7, 15-16, 18-20, 22-26 and 29-30, and adds new Claims 35-36 without introducing any new matter.

In the outstanding Office Action, Claims 1-11, 15-17 and 22-30 were rejected under 35 U.S.C. §103(a) as unpatentable over Chapman et al. (U.S. Patent No. 6,522,421, herein "Chapman") in view of Shen (U.S. Patent Publication No. 2003/0187951). Claims 12-14 and 18-21 were rejected under 35 U.S.C. §103(a) as unpatentable over Chapman and Shen and further view of Weiser (U.S. Patent No. 5,920,404).

First, Applicant wishes to thank Examiners Burgess and Meky for the courtesy of an interview granted to Applicant's representative on February 16, 2006, at which time the outstanding issues in this case were discussed. Arguments similar to the ones developed hereinafter were presented and the Examiners indicated that they would reconsider the outstanding grounds for rejection upon formal submission of a response.

In response to the Restriction Requirement being made final, Claims 31-34, directed to non-elected inventions, are canceled. Applicant reserves the right to present claims directed to the non-elected inventions in a divisional application, which shall be subject to the third sentence of 35 U.S.C. § 121.¹

To correct minor formalities and to better comply with U.S. claim drafting practice, Claims 1-2, 5-7, 15-16, 18-20, 22-26 and 29-30 are amended. Since these changes are only formal in nature, they are not believed to raise a question of new matter.

¹ "A patent issuing on an application with respect to which a requirement for restriction under this section has been made ... shall not be used as a reference ... against a divisional application." See also MPEP 804.01.

Claim 1 is amended to recite “including a first identifier identifying the user” for clarification. This feature finds non-limiting support in the specification as originally filed, for example at page 14, lines 17-25.

In response to the rejection of Claims 1-11, 15-17 and 22-30 under 35 U.S.C. §103(a), Applicant respectfully requests reconsideration of this rejection and traverses the rejection, as discussed next.

Briefly recapitulating, Claim 1 relates to an apparatus, including, *inter alia*, a communication unit configured to receive email through a communication line from a remote site, the email having been sent by a user and including a first identifier identifying the user and data; an accumulation unit configured to store therein the data; a printout unit; an input unit configured to receive a second identifier entered by the user through direct operation thereof at a local site where the apparatus is installed; and a control unit configured to control said printout unit to print the data corresponding to the first identifier at the local site by reading the data from the accumulation unit if the second identifier matches the first identifier.

As explained in Applicant’s specification at page 3, lines 14-17, Applicant’s invention improves upon background data-output apparatuses, since it can remotely output data received via email in an environment suitable for the use of a large number of users.

Turning now to the applied references, Chapman describes a method and apparatus for automatically communicating status information regarding a document production job, wherein an E-mail address is embedded in the application file relating to the party designated to receive the status information.² However, Chapman fails to teach or suggest a communication unit configured to *receive an email* through a communication line from a remote site, the email having been sent by a user. On the contrary, Chapman explicitly

² See Chapman in the Abstract.

teaches that the method only involves *embedding email information* within an application file and that the printer can interpret the email information.³ In Chapman, the data with the email information is sent through a normal printer network, and not *via email*. Chapman does not receive an e-mail from a remote site. Chapman further shows in Figure 2 that in step 42 a file with embedded email information is sent to the printer 15.⁴ Creating a file with embedded email information, as taught by Chapman, *is not* receiving an email to a communication unit a communication line from a remote site, the email having been sent by a user, as recited in Applicant's Claim 1. Chapman is silent to any way for a printer to receive an email, and Chapman is merely able to *send out an E-mail* to an E-mail address extracted from the file, to deliver status information.⁵

The secondary reference Shen, used by the outstanding Office Action to form the obviousness-type rejection, does not remedy the deficiencies of Chapman. Shen describes a system usable to print a document, wherein the system includes receiving an email address and a password corresponding to the email addresses' account.⁶ Shen further explains that the system opens the email account based on that information and can select a document from a list of documents stored therein for printing purposes.⁷ Accordingly, Shen also fails to teach or suggest the communication unit receiving an email through a communication line from a remote site, the email having been sent by a user.

Therefore, even if the combination of Chapman and Shen is assumed to be proper, the combination fails to teach every element of independent Claim 1. Accordingly, Applicant respectfully traverses, and requests reconsideration of, this rejection based on these patents.⁸

³ See Chapman at column 1, lines 65-67 and in Claim 1.

⁴ See Chapman in Figure 2 and at column 3, lines 14-20.

⁵ See Chapman at column 3, lines 40-42.

⁶ See Shen in the Abstract and in Figure 6.

⁷ See Shen in the Abstract and at page 3, paragraph 45.

⁸ See MPEP 2142 stating, as one of the three "basic criteria [that] must be met" in order to establish a *prima facie* case of obviousness, that "the prior art reference (or references when combined) must teach or suggest all the claim limitations," (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in

Since the reference Weiser also fails to teach or suggest all the features of Applicant's independent Claim 1, Applicant respectfully submits that the rejection of Claims 12-14 and 18-21 is also believed to be overcome.

To vary the scope of protection recited in the claims, new Claims 35-36 are added. New Claim 35 depends upon Claim 1 and recites "the accumulation unit is further configured to identify a source of the email." This feature finds non-limiting support in the disclosure as originally filed, for example at page 17, lines 10-23 with corresponding Figure 3. New Claim 36 depends upon Claim 1 and recites "the communication unit is connected to the internet and is configured to receive the email from the internet." This feature finds non-limiting support in the disclosure as originally filed, for example at page 35, lines 12-14. Therefore, new Claims 35-36 are not believed to raise a question of new matter.⁹

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-2, 4-30 and 35-36 is earnestly solicited.

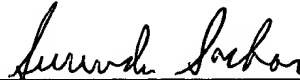
judging the patentability of that claim against the prior art."

⁹ See MPEP 2163.06 stating that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter."

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

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